

## REMARKS

Claims 1 to 25 and 29-31 are pending in the case. Claims 26-28 have been cancelled. The Examiner's reconsideration of the objections and rejections is respectfully requested in view of the amendments and the remarks.

The drawings have been objected to as failing to show the features of claim 23. A proposed drawing correction is attached hereto adding Figure 6.

Claims 8, 19, 21, and 23-25 have been objected to under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention.

Claims 8, 19, 21, and 23-25 have been amended to correct the lack of antecedent basis for the terms indicated by the Examiner. The Examiner's reconsideration of the objection is respectfully requested.

Claims 1-16 and 18-22 have been rejected under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al. (U.S. Patent No. 5,482,029). The Examiner stated essentially that Sekiguchi teaches all the limitations of claims 1-16 and 18-22.

Claim 1 claims, *inter alia*, "determining, pre-operatively, at least one instrument configuration, wherein the configuration describes at least one parameter for aligning a tip of the instrument with a target." Claim 12 claims, *inter alia*, "determining, pre-operatively, at least one endoscope configuration of the parameters, based on a predetermined patient model."

Sekiguchi teaches how to collect data during a procedure and determine flexible pipe control patterns suitable for the current situation (see col. 10, lines 48-60). Sekiguchi does not teach "determining, pre-operatively, at least one instrument configuration,

wherein the configuration describes at least one parameter for aligning a tip of the instrument with a target" as claimed in claim 1 or "determining, pre-operatively, at least one endoscope configuration of the parameters, based on a predetermined patient model" as claimed in claim 12. Sekiguchi's method is performed during a diagnosis portion of an operation (see col. 10, lines 32-37), for example, the flexible pipe control patterns are determined based on patient pain experienced during the operation. Sekiguchi does not teach how to determining a flexible pipe control patterns pre-operatively. Sekiguchi does not teach "determining, pre-operatively, at least one instrument configuration" as claimed in claim 1 or "determining, pre-operatively, at least one endoscope configuration" as claimed in claim 12. Therefore, Sekiguchi does not teach all the limitations of claims 1 and 12.

Further, with respect to claim 1, Sekiguchi does not teach "the configuration describes at least one parameter for aligning a tip of the instrument with a target." Sekiguchi's flexible control patterns determine a flexibility of an endoscope (see col. 9, lines 55-50). The flexible control pattern is used to ease movement of the endoscope but does not relate to an alignment of an endoscope tip. The flexibility control pattern of Sekiguchi does not describe a parameter for aligning a tip of the instrument with a target. Therefore, Sekiguchi fails to teach all the limitations of claim 1.

Claims 2-11 depend from claim 1. Claims 13-16 and 18-22 depend from claim 12. The dependent claims are believed to be allowable for at least the reasons given for the independent claims. At least claims 3-6, 10, 16, and 18, 20, 22 and 24 are believed to be allowable for additional reasons.

Claim 3 claims, *inter alia*, “determining an instrument length.” Claim 4 claims, *inter alia*, “determining a shaft rotation of the flexible instrument.” Claim 5 recites, *inter alia*, “determining an angle of deflection of a tip of the instrument.” Claim 6 claims, *inter alia*, “determining a tool length.” Claim 10 claims, *inter alia*, “wherein at least one parameter of the configuration is determined relative to an anatomical landmark.” Claim 16 claims, *inter alia*, “determining a configuration relative to a landmark.” Claim 18 recites, *inter alia*, “determining an endoscope length parameter.” Claim 20 claims, *inter alia*, “determining a shaft-rotation of the endoscope according to a landmark.” Claim 22 claims, *inter alia*, “determining a bending angle of the endoscope.” Claim 24 claims, *inter alia*, “determining a tool length, wherein the tool is coupled to a tip of the endoscope; and determining a distance between the tip of the endoscope and a target.”

Referring to claims 3-6, 18, 20, 22, and 24; Sekiguchi teaches determining a flexible control pattern of an endoscope (see col. 9, lines 55-50). Sekiguchi’s flexible control pattern relates to one parameter of the endoscope, flexibility (see col. 6, line 66 to col. 7 line 4, and col. 8 lines 8-11). Sekiguchi does not teach parameters including an instrument length as claimed in claim 3, a shaft rotation essentially as claimed in claims 4 and 20, an angle of deflection essentially as claimed in claim 5, a tool length as claimed in claims 6 and 24, an endoscope length essentially as claimed in claim 18, or a bending angle essentially as claimed in claim 22. Sekiguchi teaches that the flexibility of an endoscope can be determined as a flexibility control pattern. Sekiguchi does not teach that other parameters can be determined. Therefore, Sekiguchi fails to teach the limitations of claims 3-6, 18, 20, 22, and 24.

Referring to claims 10 and 16; Sekiguchi teaches determining a flexibility control pattern of an endoscope according to patient data including feelings of pain (see col. 10, lines 32-37. Sekiguchi does not teach, “wherein at least one parameter of the configuration is determined relative to an anatomical landmark” as claimed in claim 10 or “determining a configuration relative to a landmark” as claimed in claim 16. Sekiguchi is concerned with ease of operation, that is, avoiding causing pain to a patient through determining a flexible control pattern (see col. 12, lines 14-18). Sekiguchi does not teach determining the flexibility control pattern relative to an anatomical landmark. Therefore, Sekiguchi does not teach all the limitations of claims 10 and 16.

Claim 17 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi. The Examiner stated essentially that Sekiguchi teaches or suggests all the limitations of claim 17.

Claim 17 depends from claim 12. Claim 17 is believed to be allowable for at least the reasons given for claim 12. The Examiner’s reconsideration of the rejection is respectfully requested.

New claims 29 and 30 depend from claim 1. New claim 31 depends from claim 12. The dependent claims are believed to be allowable for at least the reasons given for claims 1 and 12. At least claim 30 is believed to be allowable for additional reasons.

Claim 30 claims “wherein the instructions guide a blind biopsy of the target.” Sekiguchi teaches inserting an endoscope (col. 7, lines 19-20). Sekiguchi does not teach a blind biopsy. Therefore, Sekiguchi fails to teach all the limitations of claim 30.

For the forgoing reasons, the present application, including claims 1 to 26 and 29-31, is believed to be in condition for allowance. The Examiner's early and favorable action is respectfully urged.

Respectfully Submitted,

Date: March 26, 2004

  
Donald B. Paschburg  
Reg. No. 33,753  
Attorney for Applicants

**Mailing Address:**

SIEMENS CORPORATION  
Intellectual Property Department  
5<sup>th</sup> Floor  
170 Wood Avenue South  
Iselin, New Jersey 08830  
(732) 321-3191  
(732) 321-3030 (FAX)